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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,682	12/04/2003	Terri Pickering	PIC.002.P	8463
7590	06/10/2005		EXAMINER	
David B. Waller Suite 214 5677 Oberlin Drive San Diego, CA 92121				REESE, DAVID C
		ART UNIT	PAPER NUMBER	3677

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,682	PICKERING, TERRI	
	Examiner David C. Reese	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Amendment: 4/18/2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 7-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____



DETAILED ACTION

This office action is in response to Applicant's amendment filed 4/18/2005.

Status of Claims

- [1] Claims 1-4, 7-12 are pending.

Drawings

- [2] The drawing(s) were previously objected for informalities. In view of Applicant's amendment, submitted on 4/18/2005, all previous objection(s) to the drawings have been withdrawn.

Specification

- [3] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 4/18/2005. Accordingly, the objection(s) to the specification have been withdrawn, and the abstract entered.

Claim Objections

- [4] Claim(s) 9 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 4/18/2005. Accordingly, the objection(s) to the claim(s) 9 on the instant matter has been withdrawn.
- [5] Upon review of instant amended claims, however, claims 7-9 are objected to as the statement "said means for affixing" lacks antecedent basis in Claim 1.

Claim Rejections - 35 USC § 102

[6] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[7] Claims 1-2, 7, 10 are rejected under 35 U.S.C. 102(b) as clearly anticipated by DiDomenico, US- 5,154,068, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, DiDomenico teaches of an earring for a pierced ear comprising:

a) a shaft (20), said shaft being mounted on a base (18);

(b) a connector (12) having a top surface (24) and a bottom surface (26), a cavity (inside 24) with means for engaging said shaft (20) that fits flush against pierced ear (50) on said bottom

Art Unit: 3677

surface (26) and an adapter (28) projecting from said top surface (24) of the connector on the obverse; and

(c) a cap (14) having a cavity (36) to receive said adapter (28) on one side and a decorative aspect of the earring attached on the obverse (30).

Re: Claim 2, wherein said shaft comprises or is made of a hypoallergenic material (Claim 1).

Re: Claim 7, wherein said means for affixing to said adapter is a clasping device (36 over 28 can be considered a clasping device).

As for Claim 10, DiDomenico teaches of a method of wearing an earring for a pierced ear comprising a shaft (20), said shaft having a base (18); a connector (12) having a top surface (24) and a bottom surface (26), a cavity (inside 24) with means for engaging said shaft (20) that fits flush against pierced ear (50) on said bottom surface (26) and an adapter (28) projecting from said top surface (24) of the connector on the obverse; and a cap (14) having a cavity (36) to receive said adapter (28) on one side and a decorative aspect of the earring attached on the obverse (30) comprising the step of:

(a) inserting said shaft (20) through a pierced ear (50) having a front end (50) and a back (52) wherein said base (26) is flush against said back of said ear (50) and said shaft (20) protrudes from said front of said ear (50);

(b) affixing said connector (12) onto said shaft by inserting said shaft (20) into said cavity (inside of 24) wherein said adapter (28) is positioned away from said front of said ear (50); and

(c) affixing said cap (14) to said adapter (28) such that said decorative aspect (30) is positioned away from said front (50) of said ear.

Art Unit: 3677

[8] Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kogen, 5,743,113.

Kogen teaches of a pierced earlobe protector.

As for Claim 1, Kogen teaches of an earring for a pierced ear comprising:

a) a shaft (22), said shaft being mounted on a base (26);

(b) a connector (30) having a top surface (36) and a bottom surface (34), a cavity (38)

with means for engaging said shaft (22) that fits flush against pierced ear (24) on said bottom surface (34) and an adapter (42) projecting from said top surface (36) of the connector on the obverse; and

(c) a cap (32) having a cavity (54) to receive said adapter (42) on one side and a

decorative aspect of the earring attached on the obverse (62).

Re: Claim 9, wherein said means for affixing comprises a pin (30) having a flat head (34) extending perpendicularly from the obverse side of said connector (30); and said cap (32) having a keyhole-shaped slot (54) capable of receiving said pin head (54 of cap receiving 46 in Fig. 1; notice how 46 fits into 54 with indentations on the top and bottom resembling a key-hole shape).

[9] Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Heckmann, 216,954.

Heckmann teaches of an earring.

As for Claim 1, Heckmann teaches of an earring for a pierced ear comprising:

a) a shaft (b), said shaft being mounted on a base (a);

(b) a connector (c) having a top surface (c') and a bottom surface (c''), a cavity (inside of

c) with means for engaging said shaft (b) that fits flush against pierced ear on said bottom

Art Unit: 3677

surface (c'') and an adapter (c') projecting from said top surface (c') of the connector (c) on the obverse; and

(c) a cap (f) having a cavity (inside of f) to receive said adapter (c') on one side and a decorative aspect of the earring attached on the obverse (f').

Re: Claim 3, wherein said shaft (b) is threaded and wherein said means for engaging said shaft is threaded in said cavity able to receive said threaded shaft (col. 1, it is stated by Heckmann of past prior art utilizing threads as a means of fastening components of such an earring, and how his invention is an improvement of such a methods because, "the thread also soon wears out, and the nut is useless in holding the ear-drop in the ear." Examiner would also like to point out that it would have been an obvious matter of art recognized equivalence to utilize a threaded fastening relationship between two components, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Hartmann. That is, it is well known in the art of jewelry and/or fasteners of the use of a threaded relationship to connect two components together. It is merely up to the user when developing the device as to what type of fastening means will be used (threaded, grooved, magnetic, retaining mechanism, etc...).

Re: Claim 4, wherein said shaft (b) is grooved and wherein said means for engaging said shaft are depressions in said cavity that interlock with said grooved shaft (col. 1, it is stated by Heckmann of past prior art utilizing threads/grooves as a means of fastening components of such an earring, and how his invention is an improvement of such a methods because, "the thread also soon wears out, and the nut is useless in holding the ear-drop in the ear." Examiner would also like to point out that it would have been an obvious matter of art recognized equivalence to

Art Unit: 3677

utilize a threaded fastening relationship between two components, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Hartmann. That is, it is well known in the art of jewelry and/or fasteners of the use of a threaded/grooved relationship to connect two components together. It is merely up to the user when developing the device as to what type of fastening means will be used (threaded, grooved, magnetic, retaining mechanism, etc...).

As for Claim 12, Heckmann teaches of an earring for a pierced ear comprising:

- a) a shaft (b), said shaft being mounted on a base (a) having a magnetic charge (see below);
- (b) a connector (c) having a top surface (c') and a bottom surface (c''), a cavity (inside of c) with means for engaging said shaft (b) that fits flush against pierced ear on said bottom surface (c'') and an adapter (c') having an opposite magnetic charge (see below) on the obverse; and
- (c) a cap (f) having a means for affixing to said adapter (c') on one side and a decorative aspect of the earring attached on the obverse (f').

Examiner takes official notice that it is old and well known to use magnetic attraction to combine two components. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have additionally incorporated an embodiment in which the two components were connected via magnetic attraction. It is merely up to the user when developing the device as to what type of fastening means will be used (threaded, grooved, magnetic, retaining mechanism, etc...).

Claim Rejections - 35 USC § 103

[10] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[11] Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kogen, 5,743,113 in view of Float et al., 5,893,278.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Kogen teaches of that claimed in Claim 1.

However, Kogen fails to disclose expressly of structure of a component comprising a flexible component able to expand and retract to receive another component such as a connector.

Float et al. teaches of an earring having an improved retaining mechanism (10 in Fig. 1) in which the assembly has the ability to expand and retract around a stem of an earring (12) to improve the characteristic locking, fastening or retaining ability of the earring (40 into 20 onto stem 12 in Fig. 1 of Float et.al.).

Art Unit: 3677

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the earring piercing and fastening system taught by Biagi, to incorporate a possible retaining mechanism as taught by Float et al., in order to as create another embodiment of connection between pieces revolving around a retaining mechanism. Thus, it is easy to discern why such an embodiment of utilizing an expanding and retracting design would be desired since it would strongly increase the ease of assembly and to deter possible inadvertent disengagement between two components in the pierced ear.

[12] Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiDomenico, US- 5,154,068 in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

DiDomenico teaches of an earring with all the features as stated from Claim 1. DiDomenico provides all of the structural aspects of that claimed in Claim 1 (shaft, base, connector, caps, etc, but does not however, teach of a plurality of such components. Examiner would like to point out that it would have been obvious to one having ordinary skill in the art at the time the invention was made, to comprise a plurality of the above components, as it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. See also, MPEP § 2144.05 which states: *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a

water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies ** in the joint, and a plurality of "ribs" ** >projecting outwardly from each side of the web into one of the adjacent concrete slabs. <The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.).

Further, developing a plurality of such components also incorporates the fact that different sizes and shapes may also be utilized. Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Response to Arguments

[13] Applicant's amendment, see amendment and remarks filed 4/18/2005, with respect to the rejection(s) of claim(s) 1-4, 7, 10-11 under Biagi, US-6,105,392, have been fully considered. Therefore, the rejection with regard to Biagi has been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of DiDomenico, US- 5,154,068 with regard to Claims 1-2, 7 and 11; while other rejections have been made in light of the other claims 3-4, and 11, and thus arguments as supplied by applicant with regard to these specific claims are in moot to the new grounds of rejection.

[14] Applicant's amendment filed 4/18/2005 regarding rejections under 35 U.S.C. 102 with regard to Claims 1 and 9 under Kogen have been fully considered but that disclosed by Kogen still reads under the newly amended claims.

Though applicant intends on Claim 1 to be inferred that the connector is not inserted into the body pierce, this is not claimed. What is claimed is that the connector's bottom surface sits flush against said pierced ear. As one can tell in Fig. 1 of Kogen, 34 is indeed sitting flush, with the earlobe 24. So thus, in response to Applicant's argument that Kogen does not include certain features of Applicant's invention, the limitations on which the applicant relies (not inserted into the body pierce) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Further, and possibly more important, is that though Kogen includes additional structure not required by Applicant's invention, it must be noted that Kogen discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

In Claim 1, Kogen has indeed satisfied every structural feature as claimed as claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974), and with regard to the ornamentation, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

[15] Applicant's arguments filed 4/18/2005 regarding rejections under 35 U.S.C. 103 with regard to Claims 5, 6 have been fully considered but are in moot since the instant claims have been canceled.

[16] Applicant's arguments filed 4/18/2005 regarding rejections under 35 U.S.C. 103 with regard to Claim 8 have been fully considered but they are in moot due to the prior art maintaining anticipation toward Claim 1.

Conclusion

[17] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[18] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

Art Unit: 3677

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677

DCR



ROBERT J. SANDY
PRIMARY EXAMINER